

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86429573
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86429573/large
LITERAL ELEMENT	SECURITY DNA
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_3898186130-20160308161543520411_.TWTM053_ResponseFOAdated9-10-15.pdf
CONVERTED PDF FILE(S) (11 pages)	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0004.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0005.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0006.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0007.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0008.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0009.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0010.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0011.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\295\86429573\xml7\RFR0012.JPG
DESCRIPTION OF EVIDENCE FILE	Please see the actual argument text within the Evidence section.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Marianne Buckley/
SIGNATORY'S NAME	Marianne Buckley
SIGNATORY'S POSITION	Attorney of record, IL bar member
SIGNATORY'S PHONE NUMBER	312-580-1020
DATE SIGNED	03/08/2016
AUTHORIZED SIGNATORY	YES

CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Mar 08 16:31:14 EST 2016
TEAS STAMP	USPTO/RFR-XX.XX.XXX.XXX-2 0160308163114762709-86429 573-5505f535fceb94d13a0a0 af506efb8ab2c20aa9b4efe3e 6bceb6a9f1a21e4ca47f-N/A- N/A-20160308161543520411

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86429573** SECURITY DNA(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86429573/large>) has been amended as follows:

EVIDENCE

Evidence in the nature of Please see the actual argument text within the Evidence section. has been attached.

Original PDF file:

[evi_3898186130-20160308161543520411_.TWTM053_ResponseFOAdated9-10-15.pdf](#)

Converted PDF file(s) (11 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Marianne Buckley/ Date: 03/08/2016

Signatory's Name: Marianne Buckley

Signatory's Position: Attorney of record, IL bar member

Signatory's Phone Number: 312-580-1020

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86429573

Internet Transmission Date: Tue Mar 08 16:31:14 EST 2016

TEAS Stamp: USPTO/RFR-XX.XX.XXX.XXX-2016030816311476

2709-86429573-5505f535fceb94d13a0a0af506

efb8ab2c20aa9b4efe3e6bceb6a9f1a21e4ca47f

-N/A-N/A-20160308161543520411

**Response to Office Action Dated September 10, 2015: Request for Reconsideration and
Suspension of Action**

In the Office action dated September 10, 2015, the Office maintains the rejections of the mark "SECURITY DNA" ("the Applied-for Mark") as allegedly confusingly similar to U.S. Trademark Registration No. 3,610,580 for the mark "SECURE DNA" ("the '580 Registration") and U.S. Trademark Registration No. 3,743,195 for the mark "SECURITY IS IN OUR DNA" ("the '195 Registration"). The Applicants traverse the rejections.

Since the present Office action issued on September 10, 2015, the '580 Registration has been cancelled. Thus, the likelihood of confusion rejection based on the '580 Registration is moot. Further, the '195 Registration has entered the grace period for renewal. Accordingly, suspension of action for the present application is requested pending the disposition of the '195 Registration at the expiration of the grace period. Moreover, there is no likelihood of confusion between the Applied-for Mark and the '195 Registration and, thus, the likelihood of confusion rejection based on the '195 Registration should be withdrawn.

The Applicants file herewith a notice of appeal to preserve the pendency of this application.

I. The §2(d) Rejections Based on U.S. Registration No. 3,610,580 are Moot.

The '580 Registration was cancelled on November 27, 2015, because the registrant did not file a declaration of use under § 8. *See* Appendix A, copy of TSDR "Status" webpage for the '580 Registration. In view of the cancellation of the '580 Registration as shown in the Trademark database, the likelihood of confusion rejection based on the '580 Registration is

moot. Withdrawal of the §2(d) rejection of the Applied-for Mark based on the now-cancelled '580 Registration is requested.

II. Action Must Be Suspended in view U.S. Registration No. 3,743,195.

The '195 Registration registered on January 26, 2010. *See* Appendix B copy of TSDR "Status" webpage for the '195 Registration. On January 26, 2016, the '195 Registration period entered the grace period for filing a declaration of use under § 8 to maintain the registration. As of the filing of this paper, the registrant of the '195 Registration have not yet filed a declaration under § 8. *See id.* The grace period ends on July 26, 2016. Accordingly, the Applicants request that action on the present application, including any action in connection with the intended appeal, be suspended until the registrant of the '195 Registration either files a timely declaration under § 8 or the registration is cancelled for failure to file such a declaration. This request for suspension is appropriate, as 37 C.F.R. § 2.67 provides that "[a]n applicant's request for a suspension of action under this section within the 6-month response period . . . may be considered responsive to the previous Office action."

In view of the cancellation of the '580 Registration, the '195 Registration remains the only registration forming an alleged basis for refusal to allow the present application for the Applied-for Mark. If the '195 Registration is cancelled, no other alleged bases will exist for refusal to allow the present application. Accordingly, suspension of action until a determination is made on the status of the '195 Registration is warranted to determine whether the alleged § 2 rejections based on the '195 Registration as an active registration can stand.

Indeed, action in the present application must be suspended in view of the grace period status of the '195 Registration. TMEP § 716.02 states that:

[I]f the examining attorney is ready to issue a denial of a request for reconsideration of a final refusal of registration under §2(d), and *the cited registration is in the grace period for filing a §8 or §71 affidavit* or §9 renewal application, *the examining attorney must suspend action*. If the registrant timely files, and the USPTO accepts, the §8 or §71 affidavit and/or the cited registration is renewed, the examining attorney will remove the application from suspension and issue an Examiner’s Subsequent Final Refusal, thereby giving the applicant six months in which to file an appeal.

(emphasis added). Thus, suspension of action for the present application in view of the status of the ‘195 Registration as being in the grace period for renewal or cancellation is requested.

III. There Is No Likelihood of Confusion Between the Applied-for Mark and U.S. Registration No. 3,743,195.

The Office maintains the § 2(d) rejection of the Applied-for Mark, SECURITY DNA, as allegedly confusingly to the SECURITY IS IN OUR DNA mark of the ‘195 Registration. In particular, the Office relies on arguments that the marks are similar in appearance and sound “because both marks begin with the word SECURITY and end with the term DNA.” *See* present Office action. Further, the Office argues that Applied-for Mark is merely a deletion of the phrase “is in our” from the mark of the ‘195 Registration. *See id.* However, the Office fails to consider the distinct commercial impressions generated by each mark that amount to more than a mere sharing of common words, as alleged in the Office action.

Two marks sharing some, but not all, words have been found to create distinct commercial impressions. For example, the court in *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) found dissimilarities between the marks “RITZ” for bath towels and “PUTTING ON THE RITZ” for shower curtains, which the court found to be related goods. The court held that “PUTTING ON THE RITZ” conjured images of “fancy, even swanky, ladies in full length gowns and gentlemen in tails and top hats congregating in a large Art Nouveau

restaurant” while “RITZ” invoked images of “cleaning, cooking, or manual labor generally.” *Id.* As further support for finding the marks not to be confusingly similar, the court also noted that “[t]he two marks also differ in terms of sound and appearance. . . . RHL's mark contains other words in addition to ‘Ritz,’ making both its visual appearance and pronunciation longer.” *Id.* (internal citations omitted). Further, the absence of words between marks can alter the way the words are used and, thus, the resulting commercial impressions and connotations. For example, the court in *Nabisco Brands Inc. v. Quaker Oats Co.*, 547 F. Supp. 692 (D.N.J. 1982) found differences between CREAM OF WHEAT and CREAMY WHEAT, both for breakfast cereal, in that the term “creamy” was used to denote a soft and smooth product.

Here, the differences in appearance and sound between the Applied-for Mark, SECURITY DNA, and the substantially longer SECURITY IS IN OUR DNA mark create distinct commercial impressions. For example, when viewed in its entirety, the Applied-for Mark, SECURITY DNA, conjures up the idea of fundamental building blocks of a security protocol for computer network, IT, and/or data protection. In contrast, SECURITY IS IN OUR DNA evokes characteristics of a person and that the person is particularly well-suited for providing security consultation. Thus, the nature of the terms used result in completely different connotations, one related to constituent or foundational elements of a computer security protocol and the other to characteristics of a person. Therefore, the differences in appearance and sound are not insubstantial, contrary to the positions in the Office action, as they create different commercial impressions.

The Office cites to evidence that allegedly supports the proposition that computer security consultancy services may emanate from a single source under a single mark by referring to three websites for technology consulting services (i.e., of <http://www.csc-inc1.com/>,

<http://www.rokasecurity.com/>, and <http://www.telos.com/cybersecurity/consulting/>). *See present* Office action. The Office also argues that the fact that consumers are sophisticated does not mean they are immune from source confusion. *See id.* However, the references to the three websites as well as the rejections in the Office action based on two marks sharing similar words (i.e., SECURE DNA and SECURITY IS IN OUR DNA) associated with services in class 42 support the fact that because customers are presented with many options for computer software and consulting services, the relevant consumer who purchases the applicant’s consulting and information technology security services has researched various sources for provided the services and has clear reasoning for selecting one source over another to provide such services. Such discriminating, often professional buyers, are aware that there are different companies offering consulting services and would be able to clearly distinguish the key elements in relation to the various service offerings between the applicant and the registrant of the ‘195 Registration. For example, as evidenced by the three websites referenced in the Office action, two of which refer to services for local and/or federal government, and the identification of the ‘195 Registration for “Consulting services to business and Government clients in the field of information technology security,” certain sources provide computer consulting services to specific entities, such as government entities. The targeted offering of services would be recognized by the discriminating buyer and contribute to the elimination of potential confusion between sources. Thus, there would be no likelihood of confusion between the mark SECURITY IS IN OUR DNA with the applicant’s SECURITY DNA.

In sum, suspension of further action in this application is requested pending the disposition of the '195 Registration at the expiration of the grace period for filing a declaration under § 8. Moreover, in light of the differences between the marks, the goods and the marketing conditions, there is no likelihood of confusion between the Applied-for Mark and the '195 Registration. Allowance of the present application is respectfully requested.

Respectfully submitted,
HANLEY, FLIGHT, & ZIMMERMAN, LLC
150 South Wacker Drive, Suite 2200
Chicago, IL 60606

/Marianne Buckley/
Marianne Buckley
Attorney for the Applicant

March 8, 2016

APPENDIX A

Generated on: This page was generated by TSDR on 2016-03-08 12:47:52 EST

Mark: SECURE DNA

Secure DNA

US Serial Number: 77384908

Application Filing Date: Jan. 30, 2008

US Registration Number: 3610580

Registration Date: Apr. 21, 2009

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Supplemental

Mark Type: Service Mark

Amended to Principal Register: No

Date Amended to Current Register: Jan. 21, 2009

Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 27, 2015

Date Cancelled: Nov. 27, 2015

Mark Information

Mark Literal Elements: SECURE DNA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Computer consultation in the field of computer security; Computer security service, namely, restricting access to and by computer networks to and of undesired web sites, media and individuals and facilities; Development of software for secure network operations

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Nov. 01, 2007

Use in Commerce: Nov. 01, 2007

For: Monitoring of computer systems for security purposes

International Class(es): 045 - Primary Class

U.S Class(es): 100, 101

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Nov. 01, 2007

Use in Commerce: Nov. 01, 2007

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Secure DNA Consulting, Inc.

Owner Address: 680 Iwilei Rd., Loft 420
Honolulu, HAWAII 96817
UNITED STATES

Legal Entity Type: CORPORATION

State or Country: NEVADA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Zachary J. Antalis

Attorney Primary Email Address: zantalis@awlaw.com

Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: Zachary J. Antalis
Ashford & Wriston LLP
1099 Alakea St Ste1400
c/o Kevin W. Herring
Honolulu, HAWAII 96813
UNITED STATES

Phone: 808-539-0400

Fax: 808-533-4945

Correspondent e-mail: kherring@awlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 27, 2015	CANCELLED SEC. 8 (6-YR)	
Jun. 03, 2011	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 21, 2009	REGISTERED-SUPPLEMENTAL REGISTER	
Mar. 17, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	73296
Mar. 14, 2009	APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER	
Mar. 11, 2009	TEAS/EMAIL CORRESPONDENCE ENTERED	73296
Mar. 11, 2009	CORRESPONDENCE RECEIVED IN LAW OFFICE	73296
Mar. 09, 2009	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 08, 2009	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 08, 2009	NON-FINAL ACTION E-MAILED	6325
Mar. 08, 2009	NON-FINAL ACTION WRITTEN	82428
Feb. 19, 2009	ASSIGNED TO EXAMINER	82428
Jan. 28, 2009	TEAS/EMAIL CORRESPONDENCE ENTERED	73296
Jan. 28, 2009	CORRESPONDENCE RECEIVED IN LAW OFFICE	73296
Jan. 28, 2009	ASSIGNED TO LIE	73296
Jan. 21, 2009	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jan. 21, 2009	PETITION TO REVIVE-GRANTED	88889
Jan. 21, 2009	TEAS PETITION TO REVIVE RECEIVED	
Jan. 21, 2009	ATTORNEY REVOKED AND/OR APPOINTED	
Jan. 21, 2009	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Dec. 04, 2008	ABANDONMENT NOTICE MAILED - FAILURE TO RESPOND	
Dec. 04, 2008	ABANDONMENT - FAILURE TO RESPOND OR LATE RESPONSE	
May 08, 2008	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 08, 2008	NON-FINAL ACTION E-MAILED	6325

May 08, 2008	NON-FINAL ACTION WRITTEN	81899
May 07, 2008	ASSIGNED TO EXAMINER	81899
Feb. 05, 2008	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Apr. 21, 2009

APPENDIX B

Generated on: This page was generated by TSDR on 2016-03-08 12:48:45 EST

Mark: SECURITY IS IN OUR DNA

Security is in our DNA

US Serial Number: 77608089

Application Filing Date: Nov. 05, 2008

US Registration Number: 3743195

Registration Date: Jan. 26, 2010

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jan. 26, 2010

Publication Date: Jun. 02, 2009

Notice of Allowance Date: Aug. 25, 2009

Mark Information

Mark Literal Elements: SECURITY IS IN OUR DNA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Consulting services to business and Government clients in the field of information technology security

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 09, 2009

Use in Commerce: Feb. 09, 2009

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: Yes

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Nova Datacom, LLC

Owner Address: Suite 350
4501 Singer Court
Chantilly, VIRGINIA 20151
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country: VIRGINIA

Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Daniel S. Koch

Docket Number: 40824

Attorney Primary DKoch@PaleyRothman.com

Attorney Email No

Email Address:

Authorized:

Correspondent

Correspondent DANIEL S. KOCH

Name/Address: PALEY ROTHMAN
4800 HAMPDEN LN
BETHESDA, MARYLAND 20814-2930
UNITED STATES

Phone: 301.951.9371

Correspondent e-mail: DKoch@PaleyRothman.com

Correspondent e-mail Authorized: No

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 26, 2010	REGISTERED-PRINCIPAL REGISTER	
Dec. 23, 2009	LAW OFFICE REGISTRATION REVIEW COMPLETED	78289
Dec. 14, 2009	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Nov. 19, 2009	STATEMENT OF USE PROCESSING COMPLETE	66530
Oct. 30, 2009	USE AMENDMENT FILED	66530
Nov. 19, 2009	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66530
Oct. 30, 2009	TEAS STATEMENT OF USE RECEIVED	
Aug. 25, 2009	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jun. 02, 2009	PUBLISHED FOR OPPOSITION	
May 13, 2009	NOTICE OF PUBLICATION	
Apr. 27, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	78289
Apr. 24, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 23, 2009	TEAS/EMAIL CORRESPONDENCE ENTERED	78289
Apr. 23, 2009	CORRESPONDENCE RECEIVED IN LAW OFFICE	78289
Apr. 23, 2009	ASSIGNED TO LIE	78289
Apr. 23, 2009	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Feb. 06, 2009	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Feb. 06, 2009	NON-FINAL ACTION E-MAILED	6325
Feb. 06, 2009	NON-FINAL ACTION WRITTEN	76153
Feb. 05, 2009	ASSIGNED TO EXAMINER	76153
Nov. 10, 2008	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Dec. 23, 2009